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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/768,602   | 01/25/2001  | Thomas E. Slowe      | 040000-680          | 3821             |
| 27045  | 7590        | 08/02/2004           | EXAMINER            |                  |
| ERICSSON INC.<br>6300 LEGACY DRIVE<br>M/S EVR C11<br>PLANO, TX 75024 |             |                      | MURPHY, RHONDA L    |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2667                |                  |

DATE MAILED: 08/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/768,602             | SLOWE ET AL.        |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Rhonda L Murphy        | 2667                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6-9,11,13 and 14 is/are rejected.
- 7) ☒ Claim(s) 3,5,10 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/29/02</u> . | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Drawings*

1. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1,2,4,6-9,11,13,14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lutgen et al. (US 6,160,639) in view of Narayanaswamy (US 6,611,358).

Regarding claims 1, 7, 8 and 14, Lutgen teaches a means for determining the ability of a first (**originating facsimile machine 22**) and second terminal (**terminating facsimile machine 24**) to reproduce information (col. 4, lines 45-51); means for establishing a first channel mode for the first terminal to communicate information to the second terminal

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(col. 6, lines 39-42), using the performance of the first terminal and the bandwidth of the first terminal's connection to the second terminal (col. 5, lines 56-60); means for establishing a second channel mode for the second terminal to communicate information to the first terminal (col. 6, lines 39-42), using the performance of the second terminal and the bandwidth of the second terminal's connection to the first terminal (col. 5, lines 56-60); and means for communicating between the first and second terminal in accordance with their respective channel modes (col. 6, lines 39-42).

Lutgen fails to teach a plurality of media formats in the above listed limitations and means for producing a list of media formats - which include a plurality of formats for each particular media - and can be reproduced by the first and second terminals.

However, Narayanaswamy teaches a plurality of media formats (col. 3, lines 9-18) and means for producing a list of various media formats, reproduced by the first and second terminals (col. 5, lines 30-32).

In view of this, having the method of Lutgen and then given the teaching of Narayanaswamy, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Lutgen's method by utilizing a plurality of media formats, so as to increase capability, quality and performance of the terminals.

**Regarding claims 2 and 9**, the combined system of Lutgen and Narayanaswamy teaches all aspects of the claimed invention set forth in the rejection of claims 1 and 9 as described above. Lutgen further teaches the first channel mode established based upon one or more media, which provide a user of the first terminal with a greatest level of understanding of the information to be transmitted (col. 6, lines 21-26).

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**Regarding claims 4 and 11**, the combined system of Lutgen and Narayanaswamy teaches all aspects of the claimed invention set forth in the rejection of claims 1,2,8 and 9 as described above. Lutgen further teaches that one or more media providing a user of the first terminal with a greatest level of understanding of the information to be transmitted is determined based upon user conditions (col. 6, lines 26-38).

**Regarding claims 6 and 13**, the combined system of Lutgen and Narayanaswamy teaches all aspects of the claimed invention set forth in the rejection of claims 1,2,8 and 9 as described above.

Lutgen and Narayanaswamy's system fail to teach one or more media providing a user of the first terminal with a greatest level of understanding of the information to be transmitted is determined based upon user preferences.

Narayanaswamy further teaches that one or more media providing a user of the first terminal with a greatest level of understanding of the information to be transmitted is determined based upon user preferences (col. 4, lines 24-27).

In view of this, having the system of Lutgen and Narayanaswamy and then given the additional teaching of Narayanaswamy, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify the system of Lutgen and Narayanaswamy, to incorporate Narayanaswamy's media user preference, with the motivation to allow the end user to receive the most favorable media format.

***Allowable Subject Matter***

4. Claims 3,5,10 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Regarding claims 3 and 10**, prior art does not teach the provision of the greatest level of understanding of the information to be transmitted is determined by determining the media or combination of media which has the largest entropy per second taking into account the performance of the first terminal and the bandwidth of the first terminal's connection to the second terminal.

**Regarding claims 5 and 12**, prior art does not teach user conditions determined by using face finding and position tracking, whereby it can be determined whether a user is looking at a screen associated with a terminal.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rhonda L Murphy whose telephone number is (703) 308-9557. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on (703) 305-4798. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

rlm

  
RICKY NGO  
PRIMARY EXAMINER

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